

The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

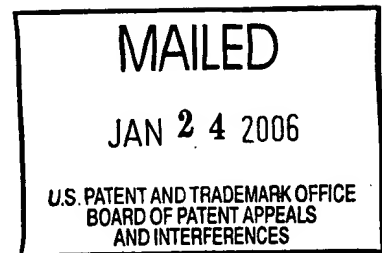
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID R. STAHL

Appeal No. 2006-0270
Application No. 09/383,857

ON BRIEF



Before THOMAS, GROSS and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 6, 8 through 18, and 20 through 24. For the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 6, 8 through 18, and 20 through 24.

THE INVENTION

The invention relates to a network based service where different sets of information are delivered to different user devices (destinations) at different times. See page 2 of appellant's specification.

Claim 1 is representative of the invention and is reproduced below:

1. A method for providing information over a computer network, comprising the steps of:
 - (a) providing for a user profile, wherein the user profile defines a schedule of two or more information requests, each information request having a corresponding destination, including a first information request having a corresponding first destination and a second information request having a corresponding second destination different from the first destination;
 - (b) preparing a set of information corresponding to each information request; and
 - (c) automatically delivering each set of information to the corresponding destination at a time based on the schedule.

THE REFERENCES

The references relied upon by the examiner are:

Gardell et al. (Gardell)	6,049,831	April 11, 2000 (filed February 13, 1997)
Gile et al. (Gile)	6,317,779	November 13, 2001 (filed Sep. 3, 1998)

THE REJECTIONS AT ISSUE

Claims 1 through 6, 8 through 18, and 20 through 24 stand rejected under 35 U.S.C. § 103(a) as being obvious over Gile in view of Gardell.¹

Throughout the opinion, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellant and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 6, 8 through 18, and 20 through 24 under 35 U.S.C. § 103(a).

Appellant argues on page 8 of the brief, that modifying Gile to deliver sets of information to different destinations would defeat Gile's purpose of providing a CD at a scheduled time. Further, appellant argues that that even if one were to

¹ We note that the examiner's answer identifies that claims 1-24 stand rejected under 35 U.S.C. § 103(a). However, claims 7 and 19 were canceled by an amendment, dated April 21, 2003 (submitted after final and entered; see the Advisory Action dated May 5, 2003).

modify Gile with Gardell, the claims would not be obvious. Appellant reasons, on pages 8 and 9 of the brief:

All that Gardell discloses in connection with the destination of downloaded information is a system in which a user can access the Internet manually from one of several different Internet access devices, and in which the destination for information downloaded in any particular session is the Internet access device from which the user is conducting that session.

Further, on page 10 of the brief, appellant argues:

Gardell suggests nothing at all regarding *specifying*, for an information request, the destination for delivery of information obtained in response to the request. Gardell teaches only that the destination for delivery of information obtained in response to a request is the Internet access device from which the request was sent.

In response, the examiner argues, on page 12 of the answer:

The examiner stated as above that Gile although does not explicitly disclose requesting network information to different devices, Gile suggests that the invention is not limited to one device receiving data across the Internet (col. 5, lines 65- col.6, line 5), and that various changes and modifications could be made without departing from the invention. In the same field of endeavor, Gardell foresees that requesting network information from Internet to one device is not flexible and inefficient. To solve this problem, therefore, Gardell provides Internet users to access network information using a variety of devices. An artisan working with Gile would be motivated to search for downloading or retrieving network information to different devices.

We disagree with the examiner's rationale. The examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). It is the


burden of the examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by the implication contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). “The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved.” *In re Huston*, 308 F.3d 1267, 1278, 64 USPQ2d 1801, 1810 (Fed. Cir. 2002, citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ 1313, 1317 (Fed. Cir. 2000)).

Claim 1 includes the limitation “providing for a user profile, wherein the user profile defines a schedule of two or more information requests, each information request having a corresponding destination, including a first information request having a corresponding first destination and a second information request having a corresponding second destination different from the first destination.” Independent claim 13 has a similar limitation. We concur with the examiner’s finding that Gile allows a user to set a schedule for the download of information requests to a destination. However, we disagree with the examiner and do not find that Gile’s statement that various changes and modifications could be made without departing from the invention (see col. 5, lines 65- col. 6, line 5), provides suggestion to modify Gile with the teachings of

Gardell. As our reviewing court has stated, when making an obviousness rejection based on combination, "there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicant" *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (quoting *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)). The statement relied upon by the examiner does not identify the desirability of making the specific modification, to have a second information request having a separate destination. Further, we do not find that Gardell provides a teaching or suggestion to have a schedule for information requests where there are two requests with different corresponding destinations. Thus, we do not find that the examiner has presented objective evidence of some, motivation or suggestion to combine the references to produce the claimed invention. Accordingly, we will not sustain the examiner's rejection of independent claims 1 and 13 under 35 U.S.C. § 103(a). Claims 2 through 6, 8 through 12, 14 through 18, and 20 through 24 all depend upon claims 1 or 13. Thus, we will not sustain the examiner's rejection of claims 2 through 6, 8 through 12, 14 through 18, and 20 through 24 under 35 U.S.C. § 103(a), for the same reasons as given with respect to claims 1 and 13.

In summary, we will not sustain the examiner's rejection of claims 1 through 6, 8 through 18, and 20 through 24 under 35 U.S.C. § 103(a). The decision of the examiner is reversed.

REVERSED


JAMES D. THOMAS)
Administrative Patent Judge)

Anita Pellman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge


ROBERT E. NAPPI
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

REN/gw

Appeal No. 2006-0270
Application No. 09/383,857

MENDELSON AND ASSOCIATES, P.C.
1500 JOHN F. KENNEDY BLVD., SUITE 405
PHILADELPHIA, PA 19102